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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**



Application Number: 10/058,924
Filing Date: January 30, 2002
Appellant(s): TSUBAKI ET AL.

John J. Dresch (Reg. No. 46, 672) and Sean M. McGinn (Reg. No. 34,386)
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 3, 2006 appealing from the Office action mailed November 29, 2005.

## *Table of Contents*

### *(1) Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

### *(2) Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### *(3) Status of Claims*

The statement of the status of claims contained in the brief is correct.

### *(4) Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

### *(5) Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

### *(6) Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### *(7) Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

## *(8) Evidence Relied Upon*

| | | |
|---|---|---|
| 5,920,317 | McDonald | 7-1999 |
| 6,038,333 | Wang | 3-2000 |
| 6,128,398 | Kuperstein et al. | 10-2000 |
| 5,737,491 | Allen et al. | 4-1998 |

"Core bibliographic information in the TIFF header", http://gdz.sub.uni-goettingen.de/en-old/tech_notes/tiffheader.html, Feb. 14, 1999.

## *(9) Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

**[R.1]** Claims 1-3, 12, 37, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald [US 5,920,317] in view of Wang [US 6,038,333].

Regarding claim 1, McDonald discloses the following claim limitations:

> An image recording method, comprising *[Figure 1]*: an information loading step of loading identification information on a subject *(i.e. patient's surname, admission id or hospital chart number)* and subject information *(i.e. matching patients)* used by a photographer to confirm an identity of the subject, in a digital camera *(i.e. 22)* before photographing the subject *[col. 5, ll. 12-14 and 19-20]*; a display step of displaying, on the basis of the subject information, subject information *(i.e. matching patients)* used by the photographer to confirm the identity of the subject on a display device before photographing the subject *[Col. 5, ll. 19-20];* a photographing step of photographing

*(i.e. ultrasound imaging)* the subject using the digital camera *(i.e. 22)* after confirming the identity of the subject *(i.e. patient)* on the basis of the subject information *(i.e. matching patient)* displayed on the display device *[22 on fig. 1; col. 5, ll. 58-61; col. 6 ll. 13-21: Ultrasonic imaging (photographing) is performed. This operation begins after the completion demographic data module, which confirms the identity of the subject through the display. See flow diagram for 22 on fig. 1]*; and a recording step of recording the photographed image *(i.e. ultrasound MPEG)* of the subject in connection with the identification information *(i.e. Admission ID)* loaded in the information loading step *[col. 6, ll. 30-45]*.

McDonald does not explicitly disclose the following claim limitations:

Displaying the subject information on a display device of the digital camera.

However, in the same field of endeavor Wang discloses the deficient claim limitations, as follows:

Displaying the subject information *(i.e. 25)* on a display device *(i.e. 22)* of the digital camera *(i.e. 20) [Figure 3A]*.

McDonald and Wang are combinable because they are from the same field of subject verification and imaging.

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald with Wang to display the subject information on the display device of the digital camera, the motivation being to create a portable handheld device *[Wang: Column 8 Lines 60-61]*.

Regarding claim 2, McDonald meets the claim limitations, as follows:

The image recording method according to claim 1, wherein the image recorded in connection with the identification information is saved to a database *(i.e. 30) [Figure 1: Compact disk]*.

Regarding claim 3, Wang meets the claim limitations, as follows:

The image recording method according to claim 2, wherein the subject information comprises at least one of the subject's photograph *(i.e. 24)* and name *(i.e. 25) [Figure 3A]*.

Regarding claim 12, Wang meets the claim limitations, as follows:

The image recording method according to claim 1, wherein the subject information comprises at least one of the subject's photograph *(i.e. 24)* and name *(i.e. 25) [Figure 3A]*.

Regarding claims 37, 38 and 40, all claimed limitations are set forth and rejected as per discussion for claims 1-3.

**[R.2]** Claims 4, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Wang further in view of "Core bibliographic information in the TIFF header" (hereinafter "TIFF") [NPL document, see PTO-892].

Regarding claim 4, McDonald and Wang meet the claim limitations as discussed in claim 2. McDonald and Wang do not explicitly disclose the following claim limitations:

> The image recording method according to claim 2, wherein the recording step records the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded.

However, in the same field of endeavor TIFF discloses the deficient claim limitations, as follows:

> TIFF discloses ability to record identification information in the header of an image file *[Page 1: ImageDescription]*.

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald and Wang with TIFF to record the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded, the motivation being the ability to sort and process digital images in a computer. This concept is notoriously well known and used in the field image file management, formats such as TIFF, JPEG and MPEG use this trivial concept.

Regarding claim 11, McDonald and Wang meet the claim limitations as discussed in claim 1. McDonald and Wang do not explicitly disclose the following claim limitations:

> The information loading step loads recorded image information containing at least one of image format, the number of pixels, compression rate, file size, and image aspect ratio.

However, in the same field of endeavor TIFF discloses the deficient claim limitations, as follows:

TIFF discloses ability to record number of pixels *(i.e. ImageWidth, ImageLength)*, compression rate *(i.e. Compression)*, file size, and image aspect ratio in the header of an image file *[Pages 1-2]*.

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald and Wang with TIFF to record number of pixels, compression rate, file size, and image aspect ratio, motivation being the ability to sort and process digital images in a computer. This concept is notoriously well known and used in the field image file management, formats such as TIFF, JPEG and MPEG use this trivial concept.

Regarding claim 13, all claimed limitations are set forth and rejected as per discussion for claim 4.

**[R.3]** Claims 5-7, 9, 10, 15-17, 19-21 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Wang further in view of Kuperstein et al. (hereinafter "Kuperstein") [US 6,128,398].

Regarding claim 5, McDonald and Wang discloses the following claim limitations:

The image recording method according to claim 1, wherein the information loading step comprises: a step of reading the subject information corresponding to the identification information, from a database having the subject information already stored in connection with the subject identification information *[Column 5 Lines 12-18]*; and a transmitting step of transmitting the subject information read from the

database, to the digital camera together with the identification information *[Column 5 Lines 12-27]*.

McDonald and Wang do not explicitly disclose the following claim limitations:

a step of reading the subject identification information from a recording medium having the identification information recorded thereon;

However, in the same field of endeavor Kuperstein discloses reading identification information from a recording medium *[12 on Figure 1]*.

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald and Wang with Kuperstein to perform reading the subject identification information from a recording medium, motivation being the ability to provide secure access *[Kuperstein, Column 4 Lines 20-31]*.

Regarding claim 6, McDonald meets the following claim limitations:

The image recording method according to claim 5, wherein while the subject identification information and the subject information are being transmitted to the digital camera, the digital camera is inhibited from being used for photographing *[Column 5 Lines 12-18, 51-55: ultrasonic imaging is started only after the completion of admission record creation, hence the camera is inhibited from photographing the subject.]*.

Regarding claim 7, Wang discloses the following claim limitations:

The image recording method according to claim 5, wherein the subject information comprises at least one of the subject's photograph *(24)* and name *(25) [Figure 3A]*.

Regarding claim 9, McDonald discloses the following claim limitations:

> The image recording method according to claim 5, wherein: the step of reading the identification information reads plural pieces of identification information so that these pieces can be accumulated *[Column 5 Lines 12-18]*; and the transmitting step transmits the identification information and the subject information in response to an information obtainment request from the digital camera *[Column 5 Lines 12-18]*.

Regarding claim 10, McDonald discloses the following claim limitations:

> The image recording method according to claim 9, wherein while the subject identification information and the subject information are being transmitted to the digital camera, the digital camera is inhibited from being used for photographing *[Column 5 Lines 12-18, 51-55: ultrasonic imaging is started only after the completion of admission record creation, hence the camera is inhibited from photographing the subject.]*.

Regarding claim 15, all claimed limitations are set forth and rejected as per discussion for claim 5. It is noted that this claim is directed toward an apparatus; hence the claim must be distinguished from the prior art in terms of structure rather than function. See In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Regarding claim 16, Kuperstein discloses the following claim limitations:

> The image recording apparatus according to claim 15, wherein the recording medium comprises one of is a card, a magnetic card, and an IC card including a bar code

recorded thereon, and the input device comprises a card reader *[12 and 14 on Figure 1]*.

Regarding claim 17, McDonald discloses the following claim limitations:

The image recording apparatus according to claim 15, further comprising a communication device which transmits the image recorded in connection with the identification information, to the database *[34 on Figure 1]*.

Regarding claim 19, all claimed limitations are set forth and rejected as per discussion for claim 5. It is noted that this claim is directed toward an apparatus; hence the claim must be distinguished from the prior art in terms of structure rather than function. See In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Regarding claim 20, all claimed limitations are set forth and rejected as per discussion for claim 16.

Regarding claim 21, all claimed limitations are set forth and rejected as per discussion for claim 17.

Regarding claim 39, all claimed limitations are set forth and rejected as per discussion for claim 5.

**[R.4]** Claims 8, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Wang further in view of Kuperstein further in view of TIFF.

Regarding claim 8, McDonald, Wang and Kuperstein meet the claim limitations as discussed in claim 5.

McDonald, Wang and Kuperstein do not explicitly disclose the following claim limitations:

> The recording step records the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded.

However, in the same field of endeavor TIFF discloses the deficient claim limitations, as follows:

> TIFF discloses ability to record identification information in the header of an image file *[Page 1: ImageDescription]*.

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald, Wang and Kuperstein with TIFF to record the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded, motivation being the ability to sort and process digital images in a computer. This concept is notoriously well known and used in the field image file management, formats such as TIFF, JPEG and MPEG use this trivial concept.

Regarding claim 18, all claimed limitations are set forth and rejected as per discussion for claim 8.

Regarding claim 22, all claimed limitations are set forth and rejected as per discussion for claim 8.

**[R.5]** Claims 14 and 23-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (hereinafter "Allen") [US 5,737,491].

Regarding claim 14, Allen discloses the following claim limitations:

An image transmitting method, comprising *[Figure 1]*: an input step of inputting destination information from an external device *(i.e. 27)* to a digital camera, the information being indicative of a destination of an image *(i.e. e-mail)*, wherein said input steps inputs destination to the digital camera using radio communication after photographing a subject to be photographed *[27 on Figure 1; Column 3 Lines 1-2, 5-10, 35-38 and 50-53; Cited reference shows a method of entering e-mail address which is a destination address for secondary communication lines. Radio communication-based keyboard and mouse are notoriously well known in the art see US 5,307,297. OFFICIAL NOTICE.]*; a photographing step of photographing the subject using the digital camera *[10 on Figure 1]*; a recording step of recording the photographed image of the subject in connection with the destination information input in the input step *[Column 2 Lines 66-67 and Column 4 Lines 21-22: All destination information and control information are stored in the header of the image.]*; and a transmitting step of transmitting the photographed subject image to the destination corresponding to the destination information, on the basis of the destination information recorded in connection with the image *[Column 3*

*Lines 1-2 and 35-38].* Applicant has not disclosed that inputting the destination information before photographing provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the destination information being input after photographing, because transmitting and recording cannot occur until the destination information is input and the order is not critical, hence a matter of design choice.

Regarding claim 23, Allen discloses an image recording method, comprising (*Figure* 1): inputting added-to-image information *(i.e. e-mail)* added to an image of a subject and display information *(i.e. display of the e-mail address)* associated with the added-to-image information are input to a digital camera from an external device *(i.e. 27)* using radio communication *[27 on Figure 1; Column 2 Lines 63-65; Column 3 Lines 1-2, 5-10 and 35-38: Radio communication-based keyboard and mouse are notoriously well known in the art see US 5,307,297. OFFICIAL NOTICE.]*; displaying the display information on a display device *(16)* of the digital camera on the basis of the display information input from the external device *[16 on Figure 1; It would be inherent that the viewfinder would display the inputted information.]*; and after photographing the subject, recording an image of the subject and also records the added-to-image information input from the external device in connection with the image *[22 on Figure 1; Column 4, Lines 21-23; Column 2 Lines 38-39, 50-53 and 57-58; Cited reference stores the identification information as control signals, which is stored in the image file containing the photograph.]*.

Applicant has not disclosed that inputting/displaying the added-to-image (i.e. e-mail or destination information as claimed in the dependent claims) information before

photographing provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the information being input/displayed after photographing because recording cannot occur until the information is input and the order is not critical, hence a matter of design choice.

Regarding claim 24, Allen discloses the image recording method according to claim 23, wherein the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image *[16 on Figure 1, Column 2 Lines 65-67: It would be inherent to check correctness of the added-to-image with the viewfinder.]*.

Regarding claim 25, Allen discloses the image recording method according to claim 24, wherein the display information comprises one of test information and image information which can be displayed on the display device *[16 on Figure 1, Column 2 Lines 65-67: It would be inherent to display the image information on the viewfinder.]*.

Regarding claim 26, Allen discloses the image recording method according to claim 24, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information *[Column 4 Lines 62-65; All files are stored in binary format in memory and text is converted to ASCII then into binary. Reverse conversion occurs to display that information.]*.

Regarding claim 27, Allen discloses the image recording method according to claim 24, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded *[Column 4 Lines 21-22 and 55-65].*

Regarding claim 28, Allen discloses the image recording method according to claim 23, wherein the display information comprises at least one of test information or image information which can be displayed on the display device *[16 on Figure 1, Column 2 Lines 65-67: It would be inherent to display the image information on the viewfinder.].*

Regarding claim 29, Allen discloses the image recording method according to claim 23, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information *[Column 4 Lines 55-65; All files are stored in binary format in memory and text is converted to ASCII then into binary. Reverse conversion occurs to display that information.].*

Regarding claim 30, Allen discloses the image recording method according to claim 23, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded *[Column 4 Lines 21-22 and 55-65].*

Regarding claim 31, Allen discloses the image recording method according to claim 23, wherein the added-to-image information comprises at least one of either numerical locational information on the subject and identification information already imparted to the subject *[Column 3 Lines 1-10, Column 4 Lines 55-60: serial number.].*

Regarding claim 32, Allen discloses the image recording method according to claim 31, wherein the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image *[16 on Figure 1; It would be inherent to check correctness and content of the added-to-image with the viewfinder.]*.

Regarding claim 33, Allen discloses the image recording method according to claim 32, wherein the display information comprises one of test information and image information which can be displayed on the display device *[16 on Figure 1, Column 2 Lines 65-67: It would be inherent to display the image information on the viewfinder.]*.

Regarding claim 34, Allen discloses the image recording method according to claim 32, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information *[Column 4 Lines 62-65; All files are stored in binary format in memory and text is converted to ASCII then into binary. Reverse conversion occurs to display that information.]*.

Regarding claim 35, Allen discloses the image recording method according to claim 32, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded *[Column 4 Lines 21-22 and 55-65]*.

Regarding claim 36, it is noted that this claim is directed toward an apparatus; hence the claim must be distinguished from the prior art in terms of structure rather than function. See

In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Allen discloses an image recording system, comprising (*Figure* 1): an external device *(i.e. 27)* which outputs, using radio communication, added-to-image *(i.e. e-mail)* information added to an image of a subject and display information *(i.e. display or the e-mail)* associated with the added-to-image information *[27 on Figure 1; Column 2 Lines 63-65; Column 3 Lines 1-10 and 35-38: Radio communication-based keyboard and mouse are notoriously well known in the art see US 5,307,297. OFFICIAL NOTICE.]*; and a digital camera comprising *(10)*: a display device *(16)* which displays the display information on the basis of the display information input from the external device using radio communication *[16 and 32 on Figure 1; Column 3 Lines 1-10 and 35-38: It would be inherent to display information on the viewfinder. Radio communication-based keyboard and mouse are notoriously well known in the art see US 5,307,297. OFFICIAL NOTICE.]*; and a recording device *(22)* which records an image of the subject after the subject has been photographed and records the added-to-image information input from the external device, in connection with the image *[22 on Figure 1 and Column 2 Lines 38-39 and 57-58; Column 4, Lines 55-65; Cited reference stores the identification information as control signals, which is stored in the image file containing the photograph.]*. Applicant has not disclosed that displaying the information before photographing provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the information being displayed after photographing because recording cannot occur until the information is input and the order is not critical, hence a matter of design choice. Furthermore, it is only a function in an apparatus claim, but an apparatus claim must be distinguished from the prior art in terms of structure rather than function

**[R.6]** Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Wang further in view of Allen.

Regarding claim 41, McDonald and Wang disclose the following claim limitations as set forth in claim 1.

McDonald and Wang do not explicitly disclose the following claim limitations:

> inputting destination information from a external device to a digital camera, wherein the destination information includes information indicative of a destination of an image; recording the photographed image of the subject in connection with the destination information input; and transmitting the photographed subject image to the destination corresponding to the destination information, on the basis of the destination information recorded in connection with the image.

However, in the same field of endeavor Allen discloses the deficient claim limitations, as follows:

> inputting destination information *(e-mail)* from a external device *(27)* to a digital camera *[27 on Figure 1; Column 3 Lines 1-10 and 35-38; Cited reference shows a method of entering e-mail address which is a destination address for secondary communication lines.]* wherein the destination information *(e-mail)* includes information indicative of a destination of an image *[27 on Figure 1; Column 3 Lines 1-10 and 35-38; Cited reference shows a method of entering e-mail address which is a destination address for secondary communication lines.]*; recording the photographed image of the subject in connection with the destination information input *[Column 2 Lines 66-67 and Column 4 Lines 21-22 and 55-65]*; and transmitting the photographed subject image to the destination

corresponding to the destination information, on the basis of the destination information recorded in connection with the image *[Column 3 Lines 1-2 and 35-38].*

It would have been obvious to one with ordinary skill in the art at the time of invention to modify the teachings of McDonald and Wang with Allen to include destination information inputs, because this provides a fast and easy way to transmit images over traditional methods *[Allen Column 1 Lines 27-30].*

## *(10) Response to Argument*

**Claim Rejections - 35 USC § 103**

*Summary of Arguments:*

Appellant argues the following:

Regarding claims 1-3, 12, 37, 38 and 40:

1. One of ordinary skill would not combine a centralized database method/system with a decentralized method/system [Brief: page 22, paragraph 4]. Appellants further argue that decentralized method/system disclosed by Wang would not provide "impeccable records" as required by McDonald [Brief: page 23, paragraph 6].

Regarding claims 8, 18 and 22:

1. Examiner has not provided evidentiary basis for the motivation in combining McDonald, Wang and Kuperstein with TIFF [Brief: page 28, paragraph 4].

Regarding claims 14 and 23-36:

1. Appellants have identified numerous examples relating to the criticality of entering the information before photographing, hence the design choice rejection should be withdrawn [Brief: page 30, paragraph 2].

2. Appellants have identified that input from an external device avoids input errors, due to avoidance of manual entry [Brief: page 30, paragraph 4]

Applicant requests the withdrawal of the rejection.

*Examiner's Response:*

Examiner respectfully disagrees.

Regarding claims 1-3, 12, 37, 38 and 40:

1. First, whether the method/system requires centralized or decentralized database in not required in the claims. Appellant bears the burden of defining their invention, hence only claim limitation need to be met. Second, displaying on the display device of digital camera does not render the system of McDonald inoperable for its intended purpose, whether the database in centralized or decentralized. The issue of centralized or decentralized is not even relevant to claims or rejections as a whole. Since, "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.").

Regarding claims 8, 18 and 22:

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, this concept is generally available to those of ordinary skill and used in the field image file management, formats such as TIFF, JPEG and MPEG use this concept. It should also be noted that TIFF was created in the mid 1980's, almost 20 years before the appellant's invention, during which other formats further developed on this concept such as JPEG.

Regarding claims 14 and 23-36:

1. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). In the instant case, appellants have failed establish the criticality of inputting information before photographing as opposed to after photographing. Appellants cited portions in the disclosure, (specification page 1, line 12; page 3, line 3; page 4, lines 22-23; page 14, line 3 to page 18, line 2), none of these portions show the criticality of inputting before as opposed to after, therefore the design choice rejection is valid. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188

USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

2. Examiner agrees that the cited potions of the specification discloses the advantages of automatic entry as opposed to manual entry, but this is not the basis for the design choice rejection. Design choice rejection is based on the inputting information after as being equivalent to inputting information before photographing.

Accordingly, Examiner maintains the rejection.

## *(11) Related Proceeding(s) Appendix*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dated: September 15, 2006

Sath V. Perungavoor
For: Bhavesh M. Mehta

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